

REMARKS

Applicants submit that the amendments herein are fully supported in the present specification as filed and add no new matter. Further, it is respectfully requested that the present Amendment be entered into the Official File in view of the fact that the Amendment automatically places the application in condition for allowance. In particular, Applicants respectfully refer the Examiner to the scope of the claims as presented herein wherein donepezil hydrochloride is recited as the basic medicine. Thus, the present Amendment is believed to be in proper form for placing the application in condition for allowance.

Applicants further note that the amended claims present no new issues requiring further search or consideration because claims of the same or similar scope have previously been presented and subsequently examined.

As an alternative, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Amendment be entered for purposes of an Appeal. The Amendment reduces the issues on appeal by reducing the number of claims (e.g., several claims canceled herein) and/or overcoming the rejections under 35 U.S.C. §§ 102(b) and 102(e). Thus, the issues on appeal would be reduced.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of the Claims

In the present Amendment, claims 1, 8, 15, 22, 25, 28, 29, 30, 33, 35-37, 41 and 43 have been amended. Also, claims 3, 4, 10, 11, 17, 18, 23, 26, 38, 39, 54 and 60 are canceled without prejudice or disclaimer of the subject matter contained therein. Claims 5, 12, 19, 24, 27, 31 and 32 were previously canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 1, 2, 6-9, 13-16, 20-22, 25, 28-30, 33-37, 40-53, 55-59 and 61-63 are pending in this application.

No new matter has been added by way of these amendments because each amendment is supported by the present specification and/or editorial in nature. For example, independent claims 1, 8, 15, 22, 25, 28, 29, 30, 41 and 43 now recite donepezil hydrochloride as the basic medicine. Donepezil hydrochloride was recited in some of the canceled dependent claims. Also, claims 33 and 35 improperly depended on claim 29 and now depend on claim 22. The amendment to claims 36 and 37 actually delete subject matter.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 102(b) & § 102(e)

Claims 1-3, 7-10, 14-17, 21 and 43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Drug Information for Vantin® (Physician's Desk Reference (1995); hereinafter "Drug Information").

Also, claims 1, 15, 20-21, 41, 43-44 and 46 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tsau *et al.* (U.S. Patent No. 5,286,489; hereinafter "Tsau '489").

Further, claims 1, 15, 20-21, 41, 43-44 and 46 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Diehl (U.S. Patent No. 5,612,026; hereinafter "Diehl '026").

Applicants respectfully traverse, and reconsideration and withdrawal of these rejections are respectfully requested.

Distinctions over Vantin®

The Examiner refers Applicants to the Vantin® disclosure regarding cefpodoxime, which is stated as being an antibiotic. However, Applicants respectfully refer the Examiner to the scope of the disputed claims and submit that such disclosure does not read upon the instantly pending claims. Thus, this rejection is overcome because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Vantin® is overcome. Reconsideration and withdrawal are respectfully requested.

Distinctions over Tsau '489

Applicants respectfully submit that this anticipatory rejection is overcome as well since Tsau '489 fails to disclose the claimed component of donepezil hydrochloride. *Verdegaal Bros.*; *supra*. Reconsideration and withdrawal are respectfully requested.

Distinctions over Diehl '026

Applicants respectfully submit that this anticipatory rejection is overcome as well since Diehl '026 fails to disclose the claimed component of donepezil hydrochloride. *Verdegaal Bros.*; *supra*. Applicants note that the Office Action merely refers to cholestyramine and colestipol. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 1-4, 6-11, 13-18, 20-23, 25-26, 28-30 and 33-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Diehl '026 in view of Vantin®.

Further, claims 1-4, 6-11, 13-18, 20-23, 25-26, 28-30 and 33-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tai (U.S. Patent No. 5,013,557; hereinafter "Tai '557").

Applicants respectfully traverse both rejections, and reconsideration and withdrawal thereof are respectfully requested.

Applicants note that a *prima facie* case of obviousness has three requirements, including disclosure of all claimed features. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442

(Fed. Cir. 1991). The cited combination of Diehl '026 and Vantin® and the modification of Tai '557 fail to disclose all instantly claimed features (e.g., donepezil hydrochloride) as recited in the disputed claims. Thus, *prima facie* cases of obviousness have not been established, and reconsideration and withdrawal of these rejections are respectfully requested. Also, allowance of all pending claims is respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

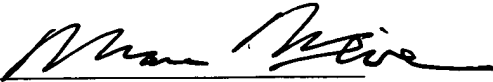
Application No. 09/380,310
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Docket No.: 0425-0736P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: JAN 27 2008

Respectfully submitted,

By 

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